

Attorney Docket No: 33332-71679  
PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

# 17

Applicant: Srikanth RAO Confirmation No. 3965  
Serial No.: 09/845,643 Art Unit: 3711  
Filed: April 30, 2001 Examiner: Steven B. Wong  
For: A GOLF BALL MARKER AND HOLDER

9/15/03

3 Loss

APPEAL BRIEF

Mail Stop Appeal Brief - Patents  
Honorable Commissioner for  
Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Below is an Appeal Brief in support of an appeal taken from the Final Rejection of claims 1, 3-7, 9-10 and 13-18, mailed May 14, 2003. A Notice of Appeal accompanies this appeal brief.

1. Real party in interest. The inventor, Sri Rao, retains all rights in this application.
2. Related appeals and interferences. Appellant and undersigned counsel for appellant know of no appeals or interferences related to the present application on appeal.
3. Status of Claims. The application contains Claims 1, 3-7, 9-10 and 13-18. Claims 1, 3, 6-7, 13 and 16-18 have been rejected under 35 U.S.C. §103(a) as unpatentable over Giglio (U.S. Patent No. 5,795,248). Claims 4-5, 9-10 and 15 have been rejected under 35 U.S.C. §103(a) as unpatentable over Giglio in view of Kennedy (U.S. Patent No. 5,393,052). Claim 14 has been rejected under 35 U.S.C. §103(a) as unpatentable over Giglio in view of Buckman (U.S. Patent No. 4,386,774).
4. Status of Amendments. All amendments filed by appellant have been entered and considered by the examiner. On May 14, 2003, a final rejection of pending claims 1, 3-7, 9-10 and 13-18 was issued. Appellant has not filed an after final amendment. Appellant's notice of appeal accompanies this appeal brief.

5. **Summary of the Invention.** The present invention is directed to a golf ball holder and marker. As best seen in Fig. 1 a holder 10 is sized for attachment to a golf shoe 11 and holds marker 20. Marker 20 and holder 10 are shown separately in Fig. 2. Fig. 3 is a side view of holder 10 showing holder 10 in the shape of a clip 12. The marker 20 can be affixed to the holder magnetically, via an interference fit, an adhesive, etc. The marker 20 fits into a recessed cavity 17 in holder 10. As disclosed, the recess depth may be less than the thickness of the marker so that a portion of the marker extends from the recess and facilitates removal of the marker from the recess. One or more indentations 16 (Fig. 2) are provided on holder 10 to facilitate easy removal of the marker 20 from the holder 10.

6. **Issues on appeal.** Whether claims 1, 3, 6-7, 13 and 16-18 are unpatentable under 35 U.S.C. §103(a) over Giglio (U.S. Patent No. 5,795,248). Whether claims 4-5, 9-10 and 15 are unpatentable under 35 U.S.C. §103(a) over Giglio in view of Kennedy (U.S. Patent No. 5,393,052). Whether claim 14 is unpatentable under 35 U.S.C. §103(a) as unpatentable over Giglio in view of Buckman (U.S. Patent No. 4,386,774).

7. **Grouping of Claims.** Claim 3 stands or falls with claim 1. Claim 7 stands or falls with claim 6. Claim 5 stands or falls with claim 4. Claim 10 stands or falls with claim 9. Each of claims 1, 4, 6, 9 and 13-18 stand or fall separately.

8. **Copy of the Claims.** A copy of the Claims on appeal is attached to this brief as Appendix A.

9. **Argument.**

The 35 U.S.C. §103(a) rejections.

In rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness.<sup>1</sup> A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art.<sup>2</sup> For the reasons that follow it is evident that there is no *prima facie* case of obviousness over the relied on prior art.

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<sup>1</sup> See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

<sup>2</sup> See *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993).

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The 35 U.S.C. §103(a) rejection of claims 1, 3, 6-7, 13 and 16-18.

Claims 1, 3, 6-7, 13 and 16-18 have been rejected under 35 U.S.C. §103(a) as unpatentable over Giglio.

Giglio discloses (Fig. 1) a golf caddy (accessory) 10 having a body member 12, a ball marker storage cavity 14, a ball marker retaining magnet 16; two tee holding cavities 18, a clip member 20, a glove attachment surface 22, a ball marker 24 and a tee 26.

Appellant's claim 1 requires a golf ball marker and holder comprising a clip that is free of golf tee attachment surfaces.... The final office action at page 2 states that "[i]t would have been obvious to one of ordinary skill in the art to remove the golf tee attachment surface (48) from the accessory of Giglio...." This argument is clearly improper. The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."<sup>3</sup> Nothing in the prior art suggests removal of the golf tee attachment surfaces in Giglio's golf caddy accessory. The statement in the final office action appears to improperly use appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art.<sup>4</sup> The argument at page 4 of the final office action that elimination of Giglio's golf tee holder amounts to nothing more than removal of parts and their associated function is incorrect. One can easily see that the device of appellant's claim 1 is not at all like Giglio's caddy without the golf tee holder portion. Appellant's claim 1 is directed to a golf ball marker and holder comprising a clip that is free of golf tee attachment surfaces, sized for attachment to a shoe, and defining a circular recessed cavity sized and positioned to receive a portion of said marker. Giglio's golf caddy accessory is not sized for attachment to a shoe. One of ordinary skill in the art would have known that Giglio's golf caddy accessory is too big and bulky to attach to a shoe, the clip would have to fit into the shoe and would be uncomfortable or injure the foot and the shape of the golf caddy 10 would snag on slacks, vegetation, etc.

Appellant's claim 1 expresses structure clearly different from, and unobvious over, Giglio.

<sup>3</sup> In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

<sup>4</sup> See Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ 2d 1237, 1239 (Fed. Cir. 1995) (citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

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Claim 18 is dependent on claim 1 and further states the clip is shaped for attachment to a shoe. The final office action at page 2 states that "the golf ball holder of Giglio is obviously capable of being attached to a shoe and thus, is obviously shaped for attachment to a shoe." Appellant's golf ball marker and holder is shown attached to a golf shoe in Fig. 1. As shown in appellant's Fig. 1 the golf ball marker and holder will not interfere with slacks worn by a golfer and is not likely to snag on plants, golf carts (when entering or exiting) or otherwise be an obstruction. Giglio does not teach or suggest that the clip is shaped for attachment to a shoe. One of ordinary skill in the art would not have attached Giglio's caddy 10 to a shoe at least because it is not shaped for attachment to a shoe. If Giglio's caddy were attached to a shoe (and it is not conceded that such is even possible) because of its size and shape it clearly would interfere by catching on all sorts of things. The attachment surface 22 in Giglio would likely stick to items (the cuffs of slacks, etc.) and would hinder as well as distract the golfer. As noted above, the clip member 20 in Giglio is constructed of metal (column 2, lines 66-67) and has the end bent at an angle such that if it were placed in the shoe it would be very uncomfortable and could even injure the foot portion that it contacts. Thus, Giglio's caddy is not sized for attachment to shoe as recited in appellant's claim 1 and it is not shaped for attachment to a shoe as recited in appellant's claim 18. The argument at the top of page 4 of the final office action that Giglio's caddy is capable of attachment to a shoe therefore is sized for attachment to a shoe is improper. The Empire State Building is capable of attachment to a shoe (as by gluing), but this does not mean it is sized for such attachment. For the reasons already expressed, one of ordinary skill in the art would not attach Giglio's caddy or the Empire State Building to a golf shoe.

For at least for these reasons, Giglio does not teach or suggest the subject matter of appellant's claims 1 and 18.

Claim 6 recites the combination of a golf ball marker and shoe. Giglio does not teach or suggest the combination of a golf shoe with the disclosed caddy and the final office action does not address this deficiency in the prior art. For the reasons noted above with respect to claim 1 (e.g., the shape and size of caddy 10), it would not have been obvious to use Giglio's caddy with a golf shoe. Claim 6 also requires a golf ball marker and shoe comprising... a clip... said clip... being free of golf tee attachment surfaces. For the reasons expressed above with respect to claim 1 it would not have been obvious to one of ordinary skill in the art to remove the golf tee attachment surface (48) from the accessory of Giglio. The rejection of claim 6 is improper and should be reversed.

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Claim 13 recites A ball marker holder comprising a monolithic strip having two portions forming the legs of a generally U-shaped member, the portions cooperating to form a space adapted to receive a portion of the wall of a golf shoe with one portion extending inside the golf shoe and the other outer portion extending along the outer wall of the golf shoe, the outer portion having a recess sized to receive a ball marker.

Giglio's caddy has a magnet 16, hook and pile surface 22, clip 20, etc. and these portions are disclosed as being of different materials as well as being different discrete elements. In Giglio the caddy does not have a monolithic strip having two portions forming the legs of a generally U-shaped member and does not have portions cooperating to form a space adapted to receive a portion of the wall of a golf shoe. The space between the clip and body in Giglio's caddy is not adapted to receive a portion of a golf shoe. The final office action statement that it would have been obvious to one of ordinary skill in the art to form the clip of Giglio from a monolithic piece is not suggested by the prior art. Because of the various shapes and different materials (magnet 16 and non-magnet parts 22, 12, 20 etc.) it would not have been possible, much less obvious, to make Giglio's caddy of a monolithic strip as recited in appellant's claim 13.

Claim 16 is dependent on claim 13 and further states the ball marker has a rim for facilitating removal of the ball marker from the marker holder. In Giglio it is stated at column 3, lines 37-41 that "[w]hen it is desired to retrieve ball marker 24 for use, portion 60 of ball marker 24 is pressed downward toward bottom surface 32 causing an edge 62 of ball marker 24 to pivot out of ball marker retaining cavity 14 where it can be easily grasped." In Giglio there is no teaching or suggestion of the combination of elements, as recited in appellant's claim 16, including a monolithic strip, portions, recess and rim. This combination in appellant's claim 16 provides a unique structure for removal of the marker attached to a golf shoe. Accordingly, reversal of the rejection of claim 16 is solicited.

Claim 17 recites a ball marker holder comprising a monolithic strip and means for releasably fixing a ball marker to the outer portion. Giglio's caddy affixes the ball marker 24 to the caddy by holding the ball marker 24 within the cavity (see Fig. 4 of Giglio). The final office action does not address the 35 U.S.C. 112, sixth paragraph, "means for" limitation of claim 17. In order for Giglio to obviate this "means for" limitation Giglio must have obviated appellant's disclosed structure, or the equivalent, for releasably fixing a ball marker to the outer portion. Such structure includes the disclosed indentations 16 and recessed cavity 17 with a depth less than the thickness of the marker so that a portion of the marker extends from the recess and facilitates, with indentation 16, removal of the marker from the

recess. Giglio does not teach or suggest any of this and does not teach or suggest an equivalent. The rejection of claim 17 is improper and should be reversed.

Finally, the statement at page 4 of the final office action that the formation of the golf tee holder of Giglio as a single integral piece instead of the referenced structures is a matter of obvious engineering choice is a conclusion, not a reason. There are many reasons why one of ordinary skill in the art would not have chosen to make Giglio's caddy of an integral piece, e.g., making the various parts of one piece would be more difficult than making it as shown in Giglio (separate parts joined together).

For all of the above reasons, the rejection of claims 1, 3, 6-7, 13 and 16-18 over Giglio should be reversed.

The 35 U.S.C. §103(a) rejection of claims 4-5, 9-10 and 15.

Claims 4-5, 9-10 and 15 have been rejected under 35 U.S.C. §103(a) as unpatentable over Giglio in view of Kennedy.

Kennedy discloses a divot repair tool having a ball mark holding recess 16 (see especially column 4, lines 15-18 of Kennedy) and a fingertip shaped indentation 60 formed in the face of the main body portion (see especially column 5, lines 11-15 of Kennedy). The final office action at page 3 states that "[i]t would have been obvious to one of ordinary skill in the art to replace the means (32) of Giglio for removing the ball marker from the cavity with the indentation of Kennedy in order to assist the user in removing the ball marker from the cavity."

Claim 4 states a face of said clip includes at least one indentation positioned adjacent said circular recessed cavity. The office action does not explain how one would have replaced Giglio's cantilevered bottom surface 32 with Kennedy's ball mark holding recess and adjacent indentation to arrive at the subject matter of appellant's claim 4. The indentation of appellant's claim 4 is positioned adjacent the recessed cavity (of claim 1) to assist in grasping the protruding rim of the marker to move the grasped rim portion upwardly out of the recess. This is not taught or suggested by Kennedy and there is no teaching or suggestion in either Kennedy or Giglio that would result in their combination to arrive at the subject matter of claim 4. It would not have been obvious to combine Giglio and Kennedy, at least, because there is no motivation to do so. Combining them as suggested in the final office action would require reconstruction of Giglio's caddy, which reconstruction is a clear indication that the combination would not have been obvious.

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Claim 4 is dependent on claim 1 and for the reasons expressed above with respect to claim 1 and for the additional reasons expressed with respect to claim 4, reversal of the rejection of claims 4 and 5 is appropriate.

Claim 9, like claim 4, states a face of said clip includes at least one indentation positioned adjacent said circular recessed cavity. For the reasons expressed above with respect to claim 4 it would not have been obvious to replace Giglio's cantilevered bottom surface 32 with Kennedy's ball mark holding recess and adjacent indentation to arrive at the subject matter of appellant's claim 9.

Claim 9 is dependent on claims 6 and 7 and, for the reasons expressed above with respect to claim 6 and for the additional reason expressed with respect to claim 9, reversal of the rejection of claims 9-10 is proper.

Claim 15 is similar to claims 4 and 9 in that it requires an indentation positioned adjacent the recess for facilitating removal of the ball marker. As expressed above with respect to claims 4 and 9 it would not have been obvious to replace Giglio's cantilevered bottom surface 32 with Kennedy's ball mark holding recess and adjacent indentation to arrive at the subject matter of appellant's claim 15.

Claim 15 is dependent on claim 13 and, for the reasons expressed above with respect to claim 13 and for the additional reason expressed with respect to claim 15, reversal of the rejection of claim 15 is requested.

The rejection of claims 4-5, 9-10 and 15 is also improper because combining Giglio and Kennedy as suggested in the office action would require substantial modification of Giglio so as to change the operation of Giglio. Giglio removes the marker by tilting it before removing it from the recess. In Kennedy such tilting is not possible. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.<sup>5</sup>

The 35 U.S.C. §103(a) rejection of claim 14.

Claim 14 has been rejected under 35 U.S.C. §103(a) as unpatentable over Giglio in view of Buckman.

Buckman discloses a ground repair tool 1 with prongs 2 and 3 and a marker retaining area 4. The marker retaining area 4 is indented from the surface of the tool 1 in a slot formed by the indented marker retaining area 4 and shoulder 5. Magnetic means 6 is secured onto

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<sup>5</sup> See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), cited at Section 2143.01 of the MPEP at page 2100-125 (August 2001).

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marker retaining area 4. The marker 7 may be magnetically secured to the magnetic means 6. Advertising or logos may be placed at location 9 or elsewhere on the tool 1 or marker 7 for use as an advertising function. In use, the marker 7 may be pushed from marker end 12 in order for the marker 7 to slide off of the magnetic means 6 in order to be detached from tool 1 and be placed where desired. (See column 2, lines 30-47).

The final office action at page 3 states that "[i]t would have been obvious to one of ordinary skill in the art to have the ball marker of Giglio extend slightly past the recess in order to facilitate removal of the ball marker." Combining Giglio and Buckman as suggested in the office action would require substantial modification of Giglio so as to change the operation of Giglio. Giglio removes the marker by tilting before removing it from the recess. In Buckman removal is by sliding. Modifying the recess in Giglio to permit sliding as in Buckman would change the principle of operation of the prior art invention being modified such that the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Moreover, there is no teaching or suggestion in either Giglio or Buckman for their combination. For example, in Giglio the marker is removed using one hand to tilt the marker so that it can be grasped by the fingers of that hand. In Buckman the size and shape of the magnet and marker suggest there must be significant holding force and that the marker is grasped and removed by one hand as the other grasps the tool portion. If Buckman's marker is not firmly attached it will come off and be lost in handling, in the golf bag, etc.

Claim 14 is dependent on claim 13 and, for the reasons expressed above with respect to claim 13 and for the additional reason expressed with respect to claim 14, reversal of the rejection of claim 14 is proper.

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**Conclusion of Argument**

From the above, it is readily apparent that the final rejection provides no *prima facie* basis for the rejections. As explained, the final office action is wrong on both law and facts. The final office action provides conclusions without proper reasons explaining the conclusions. Rather, the final office action just summarily rejects all of the claims without adequate explanation. For the foregoing reasons, the appellant, respectfully, requests that the rejections of claims 1-18 be reversed and the application with claims 1-18 be allowed.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees, be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (33332-71679).

Respectfully submitted,

BARNES & THORNBURG



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RBL/sld

**Attachment:**

Appendix (Claims 1, 3-7, 9-10 and 13-18)

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## Appendix

1. A golf ball marker and holder comprising:  
a clip that is free of golf tee attachment surfaces, sized for attachment to a shoe, and defining a circular recessed cavity sized and positioned to receive a portion of said marker;  
a marker comprising a disk that is free of an appendage and having a solid face with an image at least partially covering a central portion and being removably attached to said clip;  
one of said clip and said marker having a ferrous portion; and  
an other of said clip and said marker having a magnetic portion.
2. (canceled)
3. The golf ball marker and holder of claim 1 wherein said clip includes a magnetic portion and said marker includes a ferrous portion.
4. The golf ball marker and holder of claim 3 wherein a face of said clip includes at least one indentation positioned adjacent said circular recessed cavity.
5. The golf ball marker and holder of claim 4 wherein image includes an indicator of origin.
6. A golf ball marker and shoe comprising:  
a marker comprising a disk that is free of an appendage and having a solid face with an image at least partially covering a central portion and being removably attached to a clip;  
one of said clip and said marker having a ferrous portion;  
an other of said clip and said marker having a magnetic portion; and  
said clip defining a circular recessed cavity sized and positioned to receive a portion of said marker, being free of golf tee attachment surfaces and being clipped to a shoe.
7. The golf ball marker and shoe of claim 6 wherein said clip includes a magnetic portion and said marker includes a ferrous portion.
8. (canceled)
9. The golf ball marker and shoe of claim 7 wherein a face of said clip includes at least one indentation positioned adjacent said circular recessed cavity.
10. The golf ball marker and shoe of claim 9 wherein said image includes an indicator of origin.
- 11-12. (canceled)

13. A ball marker holder comprising:
  - a monolithic strip having two portions forming the legs of a generally U-shaped member,
    - the portions cooperating to form a space adapted to receive a portion of the wall of a golf shoe with one portion extending inside the golf shoe and the other outer portion extending along the outer wall of the golf shoe,
    - the outer portion having a recess sized to receive a ball marker.
14. The ball marker holder of claim 13 wherein the recess has a depth less than the thickness of the ball marker so that the ball marker protrudes slightly past the outer portion surface.
15. The ball marker holder of claim 13 wherein the outer portion has an indentation adjacent the recess for facilitating removal of the ball marker.
16. The ball marker holder of claim 13 wherein the ball marker has a rim for facilitating removal of the ball marker from the marker holder.
17. A ball marker holder comprising:
  - a monolithic strip having two portions forming the legs of a generally U-shaped member,
    - the portions cooperating to form a space adapted to receive a portion of the wall of a golf shoe with one portion extending inside the golf shoe and the other outer portion extending along the outer wall of the golf shoe,
    - means for releasably fixing a ball marker to the outer portion.
18. The golf ball marker and holder of claim 1 wherein said clip is shaped for attachment to a shoe.

**BARNES & THORNBURG**

Attorneys at Law

**FAX FILING COVER SHEET****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****HAND DELIVER TO:** **LARRY SCHWARTZ**  
U.S. Patent and Trademark Office**FACSIMILE:** (703) 872-9301**DATE:** August 27, 2003**FROM:** Richard B. Lazarus, Barnes & Thornburg *RSL***NUMBER OF PAGES:** 14, (Including Cover Sheet)

Applicant: Srikanth RAO

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Examiner: Steven B. Wong

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For: A GOLF BALL MARKER AND HOLDER

**FACSIMILE RESUBMISSION OF**  
**NOTICE OF APPEAL AND APPEAL BRIEF, FILED JUNE 23, 2003**

Mr. Schwartz:

Per our conversation today, attached (by facsimile only) are:

- 1) A copy of the 06/23/03 PTO date-stamped receipt card;
- 2) Notice of Appeal, filed 06/23/03; and
- 3) Appeal Brief, filed on 06/23/03

If you have any questions, please contact me.

If you have difficulty receiving this Fax, please call Barnes & Thornburg at (202) 289-1313 and ask for Sharon.

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